

REMARKS

In the Office Action mailed May 16, 2006, the Examiner rejected all pending claims 1-25 and 29-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0173318 (Dyer) and further in view of U.S. Patent Application Publication No. 2005/0049785 (Vergin).

To establish a *prima facie* case of obviousness under § 103, the cited references must teach or suggest all the claim limitations, and there must be some suggestion or motivation to combine the reference teachings. (MPEP § 2142). Applicants submit that the combination of Dyer and Vergin does not teach or suggest all elements of any of independent claims 1, 22 and 29 in as complete detail as contained in these claims, and that the Examiner has not pointed to any objective evidence that would have provided a motivation to combine the reference teachings to arrive at the present invention.

A. The combination of Dyer and Vergin does not teach or suggest “responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service”

Applicants submit that the combination of Dyer and Vergin fails to teach or suggest “in a client station, detecting a request to initiate a voice call,” and “responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service,” as in claim 1 and similarly in claims 22 and 29.

The Examiner asserted that Dyer teaches detecting a request to initiate a call (para. #0003, 0019); and responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service (para. #0019, 0032-36). Applicants respectfully disagree. Applicants submit that Dyer does not teach or suggest detecting a request to initiate a call. The paragraphs cited by the Examiner do not make any mention of detecting a request to initiate a call.

Dyer teaches a system for controlling the granularity at which a content provider is able to access positional indicia associated with the location of a mobile station. Initially a profile is created that defines indicia and levels of granularity permitted of access to positional indicia according to a user's preference. The profile is then stored in a system database. ¶[0033]. Then, when a content provider is to download data to the mobile station, a message is first sent by the content provider to the location at which the profile database is maintained, and responsive to the message, a determination is made at what level the content provider is permitted access to the positional indicia of the mobile station. ¶[0022].

Thus, Dyer does not teach or suggest "responsive to the request, sending *from the client station* into a network a message indicating how to carry out a location-based service," as in claim 1 and similarly in claims 22 and 29. Note that Dyer teaches that the content provider, not the client station, sends a message to determine the granularity preferences. In addition, Dyer does not teach or suggest determining granularity preferences *in response to* detecting a request to initiate a call. The content provider sends the message on its own accord, not due to any action of the mobile station.

The Examiner then asserted that Dyer does not specifically teach initiating a voice call, but that Vergin teaches initiating a voice call (para. #0051), and that it would have been obvious to modify the device of Dyer by adding the feature as taught by Vergin. Applicants respectfully disagree, and submit that Vergin does not make up for the short-comings of Dyer because Vergin also does not teach or suggest "in a client station, detecting a request to initiate a voice call," and "responsive to the request, sending from the client station into a network a message indicating how to carry out a location-based service," as in claim 1 and similarly in claims 22 and 29.

Vergin teaches an off-board navigation system where a user receives navigation information at a cell phone, which in turn, relays the information to the navigational unit. The

Examiner interprets Vergin as teaching detecting a request to initiate a call, because Vergin teaches that a user initially calls the call center to request directions. ¶[0051]. This teaching certainly does not amount to “in a client station, detecting a request to initiate a voice call,” as in the present claims.

The Examiner has broken down the claim limitation “responsive to the request [to initiate a voice call], sending from the client station into a network a message indicating how to carry out a location-based service.” into two parts to attempt to demonstrate that the combination of Dyer and Vergin teaches this claim limitation. Namely, the Examiner seeks to establish that since (i) Dyer teaches granularity preferences and (ii) Vergin teaches a user making a call using a mobile device, then together they teach determining granularity preferences in response to a user initiating a call.

However, the claimed step cannot be broken into the parts suggested by the Examiner. In the present application, the message is sent by the client station in response to detecting a request to initiate a call. Neither Dyer nor Vergin teach a request to initiate a call as a trigger for sending a message from the client station into the network to indicate how to do anything.

Since the combination of Dyer and Vergin does not teach the *responsive activity* recited in the present claims, the combination of Dyer and Vergin does not obviate claims 1-25 and 29-30.

B. The Examiner’s Conclusion of Obviousness is based on Improper Hindsight Analysis

To establish a *prima facie* case of obviousness under § 103 there must be some suggestion or motivation to combine the reference teachings. Applicants submit that there is no suggestion or motivation to combine the references to arrive at the present invention. Moreover, the Examiner has overlooked the responsive activity recited in the present claims when

summarily stating that there is motivation to combine the asserted references to obviate the present claims.

The Examiner's conclusion of obviousness is based on improper hindsight analysis. (MPEP § 2145[X][A]). The Examiner's manner for picking Vergin, a reference discussing a user making a call on a cell phone (that does not even mention granularity preferences), and attempting to combine it with Dyer evidences use of hindsight analysis because neither Dyer nor Vergin includes any motivation or suggestion of the specifics recited in the present claims that require the client station to perform an action in response to detecting the request to initiate the call.

Since there is no motivation to combine the cited references in the manner proposed by the Examiner, the Examiner has not established a *prima facie* case of obviousness.

CONCLUSION

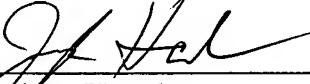
In view of the foregoing, Applicants submit that all of the pending claims are in condition for allowance over the cited references, and Applicants therefore respectfully request favorable reconsideration.

Respectfully submitted,

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